

REMARKS

The Application has been reviewed in light of the Office Action mailed June 2, 2006. At the time of the Office Action, Claims 44-63 were pending. Claims 1-43 were previously cancelled by Applicants. Claims 44-63 stand rejected. Applicants amend Claims 44, 48, 52, 54, 56, and 57 and respectfully request reconsideration and favorable action in this case.

Claim Objections

Claims 44-57 was objected to for containing lack of antecedent basis and/or inconsistent terminology. Applicants respectfully submit an amended version of claims in this set with the appropriate corrections.

Rejections under 35 U.S.C. §103

Claims 44-47 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Upgrading & Fixing PCs for Dummies: 4th Edition* by Andy Rathbone (“Rathbone”) in view of *More businesses buying PCs Online* by April Jacobs (“Jacobs”), and further in view of *Computer Security Basics* by Deborah Russell and G.T. Gangemi, Sr. (“Russell”).

Claims 48-49, 51, 58-60, and 62-63 were rejected under 35 U.S.C. §103(a) as being unpatentable over Rathbone, Jacobs, and Russell, as with Claims 44-47 above, and in further view of *Integrating Old PCs Back Into Society* by Karen Kaplan (“Kaplan”).

Claims 50 and 61 were rejected under 35 U.S.C. §103(a) as being unpatentable over Rathbone, Jacobs, Russell and Kaplan, as with Claims 48-49, 51, 58-60, and 62-63 above, and further in view of U.S. Patent No. 6,012,045 issued to Nizan Barzilai et al. (“Barzilai et al.”).

Claims 52-56 were rejected under 35 U.S.C. §103(a) as being unpatentable over Rathbone, Jacobs, and Russell, as with Claims 44-47 above, and further in view of *Are You Y2K Complaint* by Anonymous (“Anonymous”).

Claim 57 was rejected under 35 U.S.C. §103(a) as being unpatentable over Rathbone, Jacobs, Russell, and Anonymous, as with Claims 52-56 above, and further in view of Barzilai et al..

Applicants disagree and submit that the cited art combinations, even if proper, which Applicants do not concede, do not render the claimed embodiment of the invention obvious.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Finally, the prior art reference (or references when combined) must teach or suggest all the Claim limitations. Furthermore, if any Claim is nonobvious under 35 U.S.C. § 103, then any Claim depending therefrom is nonobvious. MPEP § 2143.01. Accordingly, if Applicants' independent Claims 44, 53, and 58 are nonobvious, then all remaining Claims, are nonobvious, because they depend from a nonobvious dependent Claim.

The Examiner cited *In re Shepard*, for the proposition that "it is pertinent to point out not only the specific teachings of the [reference] but also the reasonable inferences which one skilled in the art [] would logically draw therefrom." (*In re Shepherd*, 138 USPQ 148, 150 (CCPA 1963)) (Office Action, p.6). *Shepard*, however involves a non-analogous situation. *Shepard* goes on to say that:

Emphasis is therefore warranted on such phrases of the disclosure as "temperature sufficient to just melt"; "insufficient to melt"; "under these conditions"; "the extent of solution being dependent upon the time of treatment"; "We have found that the best coatings"; "interrupting the firing cycle before the point of complete solution"; and "terminating * * * heating before all of * * * higher melting alloy is dissolved."

In re Shepherd, 138 USPQ at 150.

In *Shepard*, the disclosure of the prior art actually provided phrases that a person of ordinary skill in the art could make "reasonable inference[s]" from. For example, a person of ordinary skill in the art would know "the temperature sufficient to just melt." No such disclosure is

present in the cited reference. Instead, the Examiner is attempting to import entirely new disclosure into the reference. This is impermissible. If the missing elements are inherent, the Examiner can make a showing of inherency.

1. The Rathbone-Jacobs-Russell combination does not teach or suggest all limitations of Claim 44.

Even if the Rathbone-Jacobs-Russell combination was proper, which Applicants do not concede, Rathbone-Jacobs-Russell does not teach or suggest each limitation of Applicants' independent Claim 44, from which Claims 45-52 depend. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established for Claims 44-52.

Independent Claim 44, as amended, requires, in part, "**highlighting any components of the old computer system identified by the configuration utility software as differing from the old system configuration data.**" The Examiner states that Russell "does not utilize the term 'highlighting' in regards to configuration management." (Office Action, p.9) The Examiner refers to identifiers for configuration components in Russell and the various fields that these identifiers may have. (Office Action, p.9) The Examiner then states that "such supplemental fields, as disclosed by Russell, could be utilized to 'highlight' any components that differ from the original as Russell states that 'components [are] to be tracked individually' and such fields can be utilized to represent the system 'version'." (Office Action, p.9) The Examiner provides no evidence how the identifier fields in Russell may be utilized to **highlight** any components that differ from the original. Individually **tracking** components via identifiers is not equivalent to **highlighting** differences between component configurations. Simply having information such as a version number in one component's identifier field is not the same as **highlighting** any differences between component configurations. Identifier fields do not explicitly or inherently highlight the differences in component configurations, as required by Claim 44. Thus, the cited portion of Russell neither teaches nor suggests "**highlighting any components of the old computer system identified by the configuration utility software as differing from the old system configuration data,**" as required by independent Claim 44.

Unless each element of the Claim is taught or suggested, an obviousness rejection is improper. Here, because the combination of Rathbone, Jacobs, and Russell does not teach or suggest all of the elements of Claim 44, the rejection of Claim 44 should be withdrawn and

Claim 44 should be passed to issuance. Each of Claims 45-52 depend from Claim 44, which Applicants have shown to be patentable. Therefore, Applicants request that the rejections of Claim 45-52 be withdrawn and the Claims passed to issuance.

2. The Combination of Rathbone, Jacobs, Russell, and Kaplan Do Not Teach or Suggest All Limitations of Claim 58

Even if Rathbone, Jacobs, Russell, and Kaplan could be combined for the sake of the obviousness rejection asserted by the examiner, the combination of Rathbone, Jacobs, Russell, and Kaplan does not teach or suggest each element of the rejected Claim. Applicants respectfully submit that a *prima facie* case of obviousness has not been established for Claim 58.

Independent Claim 58 requires, in part, "**computing transaction amounts with and without reuse of the reusable component, the transaction amount equal to the new computer price minus the old computer price; and selecting the lowest transaction amount.**" The Examiner, in a previous Office Action sent on December 22, 2005, stated that neither Rathbone, Jacobs, nor Kaplan "teach a method comprising computing transaction amounts with and without reuse of the reusable component; and selecting the lowest transaction amount." (Office Action from 12/22/2005, p.17). Thus, as the combination of Rathbone, Jacobs, and Kaplan does not teach or suggest the required elements of Claim 58, it must only be shown that Russell also does not teach or suggest the required elements for the combination of Rathbone, Jacobs, Kaplan, and Russell to lack the required elements as well. The Examiner has provided no evidence that Russell teaches or suggests these elements, stating only that the modification of the combination of Rathbone, Jacobs, Russell and Kaplan to include cost benefit of analysis would have been obvious.

The Examiner states that "Cost benefit analysis, such as weighing alternative courses of action, is old and well known in the art of decision-making and financial analysis." (Office Action, p.12) While the Examiner points to the general usage of cost benefit analysis as being old and well known, the specific steps of computing transaction amounts with and without reuse of the reusable component, the transaction amount equal to the new computer price minus the old computer price; and selecting the lowest transaction amount are not shown to be old and well known. Additionally, the Examiner has provided no evidence that the cited references teach or suggest these steps. The Examiner states in the present Office

Action that Jacobs teaches “computing transactions costs (price quotes) with and without reuse of the reusable component (based upon configuration),” (Office Action, p. 13). However, the cited portion of Jacobs fails to teach or suggest: the reuse of a reusable component, the transaction amount equals the new computer price minus the old computer price, and selecting the lowest transaction amount. Additionally, as stated above, the Examiner stated that Jacobs (and the combination of Rathbone, Jacobs and Kaplan) did not teach these elements in the Office Action from December 22, 2005. Finally, as stated above, Russell does not teach or suggest these elements either. Thus, the combination of Rathbone, Jacobs, Kaplan, and Russell do not teach or suggest **"computing transaction amounts with and without reuse of the reusable component, the transaction amount equal to the new computer price minus the old computer price; and selecting the lowest transaction amount,"** as required by Claim 58.

Unless each element of the Claim is taught or suggested, an obviousness rejection is improper. Because the combination of Rathbone, Jacobs, Kaplan, and Russell does not teach or suggest all of the elements of Claim 58, the rejection of Claim 58 should be withdrawn and Claim 58 should be passed to issuance. Each of Claims 59-63 depend from Claim 58, which Applicants have shown to be patentable. Therefore, Applicants respectfully request that the Examiner withdrawn the rejections of Claim 59-63 and pass the Claims to issuance.

B. There is No Suggestion or Motivation to Modify the Reference or to Combine Reference Teachings

1. There is No Suggestion or Motivation to Modify or to Combine Rathbone, Jacobs and Russell to Establish a Prima Facie Case of Obviousness for Claim 44

Even if the combination of Rathbone, Jacobs, and Russell did teach or suggest each element of the rejected Claims, which Applicants have shown is not the case, there is no suggestion or motivation to modify or to combine Rathbone, Jacobs, and Russell to establish a prima facie case of obviousness for Claim 44.

A. Modifying Rathbone Not Obvious to One of Ordinary Skill

The Examiner states that:

It would therefore have been obvious to one of ordinary skill in the art at the time the invention was made that the method utilized by Rathbone would have also utilized the ability to compare configuration data and to determine a compatible component list of components which may be reused, as is implied by Rathbone, allowing the user to determine which parts may be reused in a new computer system. (see Office Action, p. 6)

Applicants respectfully submit that it would not have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Rathbone to provide a method comprising the elements of Claim 44. Examiner states that "Comparing configuration data between two systems to access the reusability and/or compatibility of components between one or more systems is old and well-known with the art of computer system design and computer maintenance..." (see Office Action, p. 4) The knowledge of comparing configuration data between two systems alone does not provide the suggestion or motivation to combine this reference with the others provided. Additionally, there is no evidence or motivation for how determining a compatible component list indicating which components may be reused is an obvious modification to Rathbone.

Applicants respectfully submits that the Examiner has not shown that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Rathbone to provide a method comprising the above elements, and therefore a *prima facie* case of obviousness has not been established.

B. Modifying Rathbone by Incorporating Jacobs Not Obvious to One of Ordinary Skill

The Examiner states:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Rathbone by incorporating the ability to request configuration data from the manufacturer's database, as disclosed by Jacobs, to provide an additional avenue through which to secure configuration data of the old computer systems, supplementing other manufacturer documentation such as "sales receipts" and "old manuals," as disclosed by Rathbone (see pp.26 and 75)" (see Office Action, p. 8)

Applicants respectfully submit that it would not have been obvious to one of ordinary

skill in the art at the time the invention was made to have modified Rathbone to provide a method comprising the elements of Claim 44. The examiner does not give any reason why it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Rathbone other than stating that "Searching a manufacturer's database...is old and well known in the art of Internet sales and computer sales..." This knowledge alone is not suggestion or motivation to modify the reference or to combine reference teachings.

Applicants respectfully submits that the Examiner has not shown that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Rathbone by incorporating Jacobs to provide a method comprising the above elements, and therefore a prima facie case of obviousness has not been established.

2. There is No Suggestion or Motivation to Modify or to Combine Rathbone, Jacobs, Russell, and Anonymous to Establish a Prima Facie Case of Obviousness for Claim 53

Even if the combination of Rathbone, Jacobs, Russell, and Anonymous did teach or suggest each element of the rejected Claims, which Applicants do not cede, there is no suggestion or motivation to modify or to combine Rathbone, Jacobs, Russell, and Anonymous to establish a prima facie case of obviousness for Claim 53. The Examiner states, which respect to Claim 52, that:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Rathbone, Jacobs and Russell by incorporating a unique tag such as a serial number, as disclosed by Anonymous, to provide a unique identifier to the configuration request, rather than a generic identifier such as a product/model number, as disclosed by Jacobs, to properly and accurately link the configuration request to the user's specific old computer system. Furthermore, the value of unique tags for configuration data is evident based upon the "unique identifiers" disclosed by Russell as a basic concept of configuration management. *See* Office Action, page 18.

Applicants respectfully disagree that such a combination would have been obvious. The Examiner does not cite any discussion in any of the references to support why it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Rathbone, Jacobs, and Russell with respect to Claim 53. Thus there is no

suggestion or motivation to modify the reference or to combine reference teachings, and a *prima facie* case of obviousness is not established. The rejection of Claim 53 should be withdrawn and Claim 53 should be passed to issuance. Each of Claims 54-57 depend from Claim 53, which Applicants have shown to be patentable. Therefore, Applicants respectfully request that the Examiner withdrawn the rejections of Claim 54-57 and pass the Claims to issuance.

3. There is No Suggestion or Motivation to Modify or to Combine Rathbone, Jacobs, Russell, and Kaplan to Establish a Prima Facie Case of Obviousness for Claim 58

Even if the combination of Rathbone and did teach or suggest each element of the rejected Claims, which Applicants have shown is not the case, there is no suggestion or motivation to modify or to combine Rathbone, Jacobs, Russell and Kaplan to establish a *prima facie* case of obviousness for Claim 58. The Examiner states that:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Rathbone, Jacobs, Russell, and Kaplan by incorporating a cost benefit analysis of the various financial implications of alternative courses of action, as disclosed by Rathbone, Kaplan and Jacobs, allowing the user to select the optimal course of action available to him, as defined by financial implications of said course of action. *See* Office Action, page 14.

Applicants respectfully disagree. The motivation to combine based on cost benefit analysis alone is not a motivation to combine these references such that they teach or suggest every element of Claim 58. Thus, a *prima facie* case of obviousness has not been established.

CONCLUSION

For the foregoing reasons, Applicants request that Claims 44-63, as amended, be allowed. Early and favorable acceptance of this application is respectfully requested.

Applicants believe no fees are due, however, should any fees be due the Commissioner is hereby authorized to charge any fees to Deposit Account No. 02-0383 of Baker Botts L.L.P.

Respectfully submitted,

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